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EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

08/02/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/277,226

Applicant(s)

BARA ET AL.

Examiner

Alysia Berman

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Receipt is acknowledged of the information disclosure statement and priority papers filed 26 March 1999 and the change of address filed 21 June 1999. Claims 1-66 are pending.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18, 21, 27, 32, 33, 36, 43-45, 50-54 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 18, 21, 36, 43, 51, 52 and 60 all recite percents of ingredients of "from 0 to" which renders the claims indefinite. By using a lower limit of zero, the claims may contain 0%, or none, of the ingredients in the limitations. However, the claims depend from claims that require the ingredients. Clarification is requested.

5. Claim 27 is indefinite because it appears to be missing some important elements. It recites "wherein at least one silicone oil selected from cyclic polydiorganosiloxanes" but it does not say what is done with the siloxanes. Clarification is requested.

6. Claim 32 is indefinite because it is unclear to which silicones the claim is referring. Does Applicant intend to limit the amount of the oxyalkenylated silicone, the poly(C<sub>1</sub>-C<sub>20</sub>)alkylsiloxanes, the phenylsilicone oils, the silicone gum, or the silicone waxes? Clarification is requested.

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7. Claims 44 and 45 are indefinite because it is unclear what the "active principles" are. Any substance that is added to the composition could be an active principle. The specification gives examples of active principles at page 17, lines 11-13. However, the active principles are not limited to those disclosed. Therefore, the metes and bounds of the claims cannot be determined.

8. Claim 50 contains the trademark/trade name Teflon. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe synthetic fluorine containing resins and, accordingly, the identification/description is indefinite.

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-19, 23-33, 36, 39-52, 54 and 56-66 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 374 332 ('332).

EP '332 discloses a water-in-oil emulsion comprising a silicone oil, a solid wax, water and a polyoxyalkylene modified organopolysiloxane (abstract). For lipsticks and pressed powder cosmetic compositions (blusher, foundation, eyeshadow, etc.), see page 2, lines 15-19. Formula (C) at page 3 and formula (3) of claim 1 correspond to the formulas for the oxyalkenylated silicones as instantly claimed. For silicone oils corresponding to the compounds and formulas of claims 23-26 in an amount about 5% to 85% by weight of the total composition, see page 4, lines 6-35. For non-silicone waxes, see page 4, lines 36-50. The amount of the oxyalkenylated silicone is preferably 0.2% to 10% by weight (page 4, lines 56-58). For pigments and fillers such as talc, mica, titanium dioxide, zinc oxide, titanium coated mica, bismuth oxychloride, etc. in an amount up to 50% by weight, see page 5, lines 9-22. The aqueous phase may contain alcohols such as ethanol and polyols (page 5, line 26). For amino acids and hydroxyacids, see page 5, lines 27-28. For silicone wax, hydrocarbon oils, vitamins, antioxidants, thickeners, UV absorbers, etc., see page 5, lines 29-36. For poly(C<sub>1</sub>-C<sub>20</sub>)alkylsiloxanes of claim 30 in an amount up to 5% by weight, see example 8 at page 11. For 0 to 14% by weight of a lower C<sub>2</sub>-C<sub>6</sub> monoalcohol or polyol in the aqueous phase, see example 6 at pages 10-11. For active principles such as sodium chondroitin sulfate at 1.5%, see example 10 at page 12. For the amount of the aqueous phase and fatty phase, see all of the examples.

Properties such as molecular mass, viscosity and refractive index are inherent to the compounds and the composition comprising the compounds. A chemical composition and its properties are not inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. Burden is shifted to

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Applicant to show that the composition of EP '332 does not exhibit the properties instantly claimed.

Because the reference is silent as to the shape of the fillers, it encompasses any shape including non-spherical. Claims reciting "an amount up to" or "from 0 to" as written do not require the components claimed. The phrase "up to" includes zero as a lower limit. *In re Mochel*, 470 F2d. 638, 176 USPQ 194 (CCPA 1974). The addition of the oxyalkylenated silicone into the compositions inherently produces a composition with reduced transfer or migration, or inversely, increased staying power. The expression "comprising" permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. *See Moleculon Research Corporation v CBS, Inc.* 229 USPQ 805, *In re Baxter* 210 USPQ 795, 803.

11. Claims 1-19, 23-33, 36, 38-52 and 54-66 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 331 833 ('833).

EP '833 discloses water-in-oil emulsion compositions comprising one or more oxyalkenylated silicone, an aqueous phase and an oil phase containing an organic silicone resin (abstract). Formula (C) at page 6 to page 7, lines 1-5 and claim 3 correspond to the oxyalkenylated silicones as instantly claimed. Silicone oils and non-silicone hydrocarbon based oils in an amount from 5 to 90% by weight are disclosed at page 7, lines 9-17. An organic silicone resin with the silicone units as in claim 38 are disclosed at page 7, lines 56-57. Silicone oils that correspond to the compounds and structures of claims 23-26 are disclosed at page 8, lines 29-52. The amount of oil, whether silicone, hydrocarbon based or mixtures, is from 5 to 90% by weight (page 9, lines 35-36). For polyols in the aqueous phase, see page 8, lines 53-57.

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For additional ingredients such as thickeners, antioxidants, UV absorbers, extracts from plants and animals, pigments, and active principles such as amino acids, see page 9, lines 5-16. For silicone gums, see page 9, lines 29-31. For pigments and fillers such as mica, talc, nylon, titanium dioxide, iron oxide, titanium coated mica and tar type dyes, see page 9, line 52 to page 10, line 2. For amounts of a lower C<sub>2</sub>-C<sub>6</sub> monoalcohol or a polyol, aqueous phase and fatty phase, filler see the examples.

Properties such as molecular mass, viscosity and refractive index are inherent to the compounds and the composition comprising the compounds. A chemical composition and its properties are not inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. Burden is shifted to Applicant to show that the composition of EP '833 does not exhibit the properties instantly claimed.

Because the reference is silent as to the shape of the fillers, it encompasses any shape including non-spherical. Claims reciting "an amount up to" and "from 0 to" as written do not require the components in the claims. The phrase "up to" includes zero as a lower limit. *In re Mochel*, 470 F.2d. 638, 176 USPQ 194 (CCPA 1974). The addition of the oxyalkylenated silicone into the compositions inherently produces a composition with reduced transfer or migration, or inversely, increased staying power. The expression "comprising" permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. See *Moleculon Research Corporation v CBS, Inc.* 229 USPQ 805, *In re Baxter* 210 USPQ 795, 803.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102((e), f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1-19, 23-33, 36, 37 and 39-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 374 332 ('332).

EP '332 teaches all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not teach from 2 to 10% by weight of silicone waxes, the average particle size of the filler being 15 microns or less or the ratio of filler to silicone oil. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, absent evidence of unexpected and superior results, the percents and ratios are not considered critical to the invention.



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It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of EP '332 and select optimal parameters in order to achieve a beneficial effect. The motivation to do so flows logically from the art for water-in-oil emulsions with excellent stability and a good feeling on the skin. This is a *prima facie* case of obviousness.

15. Claims 1-19 and 23-33 and 36-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 331 833 ('833).

EP '833 teaches all of the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not teach from 2 to 10% by weight of silicone waxes, or the ratio of filler to silicone oil. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, absent evidence of unexpected and superior results, the percents and ratios are not considered critical to the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of EP '833 and select optimal parameters in order to achieve a beneficial effect. The motivation to do so flows logically from the art for water-in-oil emulsions with excellent stability and a good feeling on the skin. This is a *prima facie* case of obviousness.

16. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either EP 0374 332 or EP 0 331 833 each as applied to claims 1-19 above, and further in view of US 5,593,680 ('680).

EP '332 and EP '833 teach all the limitations of the claims as stated in the 35 U.S.C. 102(b) and 103 rejections above. Neither reference teaches disodium salt of ponceau, disodium

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salt of alizarin green, quinoline yellow, trisodium salt of amaranth, disodium salt of tartrazine, monosodium salt of rhodamin, disodium salt of fuchsin and xanthophyll.

US '680 discloses cosmetic compositions that contain various ingredients used in cosmetic such as dyes and pigments (col. 3, lines 36-38). For disodium salt of ponceau, disodium salt of alizarin green, quinoline yellow, trisodium salt of amaranth, disodium salt of tartrazine, monosodium salt of rhodamin, disodium salt of fuchsin and xanthophyll, see column 3, lines 58-62. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The idea of combining them flows logically from their having been individually taught in the prior art. *In re Crockett*, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (CCPA 1960).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the compositions of either EP '332 or EP '833 and substitute the dyes of US '680 with the reasonable expectation of producing a cosmetic composition. The motivation to do so flows logically from the art for colored cosmetic compositions. This is a *prima facie* case of obviousness.

17. Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over either EP 0 374 332 or EP 0 331 833 each as applied to claims 1-30 above, and further in view of US 5,478,555 ('555).

EP '332 and EP '833 teach all the limitations of the claims as stated in the 35 U.S.C. 102(b) and 103 rejections above. They do not explicitly teach the substituted linear polysiloxane waxes as instantly claimed.

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US '555 teaches cosmetic compositions comprising silicone waxes such as alkylldimethicone, dibehenoxymethicone and stearoxydimethicone in an amount from 10 to 60% by weight (col. 3, lines 20-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the compositions of either EP '332 or EP '833 and use the silicone waxes as taught by US '555 with the reasonable expectation of producing a cosmetic composition. The motivation to do so flows logically from the art-recognized desire for cosmetic sticks and cakes with good spreadability, high film-forming capacity, gloss and water resistance. This is a *prima facie* case of obviousness.

### ***Claim Objections***

18. Claims 24 and 25 are objected to because of the following informalities:  
organopolysiloxanes is misspelled. Appropriate correction is required.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703/308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

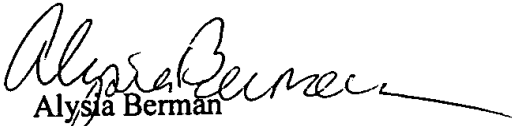
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703/308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3704 for regular communications and 703/305-3704 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-1234.



Alysia Berman  
Patent Examiner  
July 27, 2000



DIANA DUDASH  
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